

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

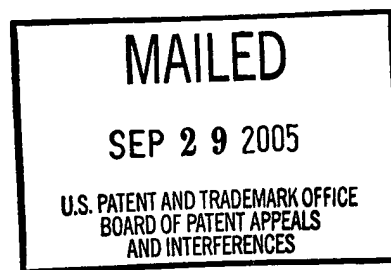
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte CHARLES R. CASH and WILLIAM DOUGLAS POYNTER

Appeal No. 2005-2369
Application No. 09/653,196

ON BRIEF



Before BLANKENSHIP, SAADAT, and NAPPI, Administrative Patent Judges.

BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 3-18, and 20-31.

We reverse and remand.

BACKGROUND

The invention relates to Management Decision Modeling (MDM). In particular, the invention relates to a type of MDM used for modeling the front end of a retail store such as a grocery, such that impact of changes to an existing or future retailer check stand or store front-end may be predicted. (Spec. at 2.) Claim 1 is reproduced below.

1. A method of quantitatively evaluating alternatives to check-out operations using simulation model, comprising:

selecting from a data input dictionary parameters describing a first check-out operations;

inputting parameter values for the selected parameters describing the first checkout operations into the simulation model;

transforming the first check-out operation parameters into check-out performance results; and

outputting the results from the simulation model.

The examiner relies on the following reference:

Kathi L. Hunt et al. (Madigan)¹, Simulation Success Stories: Business Process Reengineering, Proceedings of the 1997 Winter Simulation Conference, pp. 1275-79.

We refer to the Final Rejection (mailed Jun. 4, 2004) and the Examiner's Answer (mailed Feb. 11, 2005) for a statement of the examiner's position and to the Brief (filed Oct. 28, 2004) and the Reply Brief (filed Apr. 11, 2004) for appellants' position with respect to the claims which stand rejected.

¹ The rejection refers to the document by the name of co-author Madigan.

Claims 1, 3-18, and 20-31 stand rejected under 35 U.S.C. § 103.

Instant claim 32 was finally rejected, but appellants do not list the claim as being appealed, do not reproduce the claim in the Brief's Claim Appendix, and submit no arguments directed to the claim. We conclude that appellants have withdrawn the appeal as to claim 32. Accordingly, the appeal with respect to claim 32 is dismissed.

Claims 2 and 19 have been canceled.

OPINION

The rejection of each claim under 35 U.S.C. § 103 relies on the combination of Madigan and material that the examiner refers to as "Human Factors Engineering" (HFE). We reverse the rejections because the examiner has not established that the material can be used against appellants in a rejection under § 103.

The record indicates that the examiner mailed (Dec. 30, 2003) a first Office action on the merits that included a draftman's objection to the drawings that were submitted in the initial filing of the instant application. Appellants in response filed (Apr. 2, 2004) replacement drawings for those originally filed. In view of commentary in the Answer at pages 16 and 25, the examiner seems to find significant that original and replacement Figure 14 include the notation "February 24, 1999." We also observe that original and replacement Figure 4 contain the notation "© 1999 Corporation, All Rights Reserved," and original and replacement Figure 25 contain the notation "March

2, 1999.” The stated rejection relies on numerous figures -- for example, Figure 20 -- which do not appear to contain any notation relating to date.

The examiner does not specify a basis for the belief that appellants’ drawings may be used in the instant rejection, but seems to provide hints to help the Board ascertain some basis. At the sentence bridging pages 15 and 16 of the Answer, the examiner states that “the drawings appear to be analogous to a Power Point presentation -- thus appearing as a stand alone document -- with no one [sic] disclosure of credit to either assignee or appellant [sic].” The analysis ends in the next paragraph (at page 16), submitting that under MPEP 2129 drawings can anticipate claims, regardless of origin, and referring to “the drawing’s date of publication (2/24/99),” as it may relate to “a 35 U.S.C. 102(b) rejection.”

Initially, we note that it is not current and customary practice for drawings submitted in a patent application to contain any credit or reference to either of an applicant or an assignee. Further, we do not consider a “Power Point” presentation to be a “document,” although the examiner may be referring to electronically formatted and displayed data rather than to a human presentation. Moreover, a document (or a presentation) is not necessarily a printed publication within the meaning of 35 U.S.C. § 102(b). According to our reviewing court, public accessibility has been the criterion by which a prior art reference will be judged for the purposes of § 102(b). In re

Klopfenstein, 380 F.3d 1345, 1350, 72 USPQ2d 1117, 1120 (Fed. Cir. 2004).² That Figure 14 contains the date "February 24, 1999" is not sufficient evidence that the subject matter of the figure was accessible to the public on that (or any) date.

We note, further, that a copyright notice might tend to show the publication date of a published document, but a document that includes a copyright notice does not necessarily mean that the document was distributed to the public at any time. See generally Melville B. Nimmer et al., Cases and Materials on Copyright and Other Aspects of Entertainment Litigation Including Unfair Competition, Defamation, Privacy Illustrated, Fourth Ed., Chap. III, "Notice," West Publishing Co., pp. 182-210 (1991) (consistent with Berne convention, mandatory copyright notice was eliminated for works first published or republished after March 1, 1989).

Manual of Patent Examining Procedure (MPEP) § 2129, Eighth Edition, Rev. 2 (May 2004), referenced by the examiner, is entitled "Admissions as Prior Art." "The term 'prior art' as used in section 103 refers at least to the statutory material named in 35 U.S.C. § 102. However, section 102 is not the only source of section 103 prior art. Valid prior art may be created by the admissions of the parties." Riverwood Int'l Corp. v. R.A. Jones & Co., Inc., 324 F.3d 1346, 1354, 66 USPQ2d 1331, 1337 (Fed. Cir. 2003) (citations omitted).

² A presentation that includes a transient display of slides is likewise not necessarily a "printed publication." Klopfenstein at 1349 n.4, 72 USPQ2d at 1120 n.4.

In the instant case, the only possible “admission” by appellants must arise from the drawings that were submitted. See In re Nomiya, 509 F.2d 566, 570-71, 184 USPQ 607, 611-12 (CCPA 1975) (by filing an application containing figures labeled as prior art, and statements explanatory thereof, appellants conceded what was to be considered as prior art in determining obviousness of their improvement). However, the instant specification drawings do not contain the notation “Prior Art,” nor any other indication that the figures are to be construed as prior art against appellants.

We thus conclude there is no reasonable basis to hold that the drawings submitted by appellants may be used against them in a rejection under § 103. Had the examiner believed the drawings were suggestive of publications or activity that could have a bearing on the patentability of the instant claims, the examiner could have required the submission of information pursuant to 37 CFR § 1.105, under the guidelines set forth in MPEP § 704. In fact, appellants do not know why such a requirement was not made (Reply Brief at 10 n.3).³

Appellants’ principal argument in defense of instant claim 1 appears to be that the supplied evidence does not teach a “data input dictionary” (Brief at 9-10). According to the instant specification at page 12, lines 4 through 5, a data input dictionary lists and defines all the parameters under the user’s control, although the

³ In any event, appellants have a duty to disclose to the Office all information known to be material to patentability with respect to each pending claim.

language of the claim is not so limited. Appellants address page 1277, left column, first paragraph, lines 3 and 4 of Madigan, but do not address the remainder of the paragraph. The reference discloses that the model accommodates several input parameters characterizing the retail environment, allowing the user to, for example, specify the number of lanes in the store. Appellants do not explain why the more relevant part of the disclosure fails to disclose or suggest a “data input dictionary” within the meaning of claim 1.

Rather than entering new grounds of rejection against at least broadest claim 1 under the provisions of 37 CFR § 41.50(b) (September 13, 2004), we remand the application so that the examiner may reconsider the prior art to be applied against any or all of the claims in view of our determination that the specification figures cannot serve as prior art as to appellants.


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CONCLUSION

The rejection of claims 1, 3-18, and 20-31 under 35 U.S.C. § 103 is reversed.

The appeal with respect to claim 32 stands dismissed. The application is remanded to the examiner's jurisdiction.

REVERSED and REMANDED


HOWARD B. BLANKENSHIP
Administrative Patent Judge


MAHSHID D. SAADAT
Administrative Patent Judge

BOARD OF PATENT
APPEALS
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ROBERT E. NAPPI
Administrative Patent Judge

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